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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,374	08/02/2006	Aurelio Romeo	5059-0103PUS1	8447

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EXAMINER
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PRATT, HELEN F

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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04/14/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,374	<b>Applicant(s)</b> ROMEO, AURELIO	
	<b>Examiner</b> Helen F. Pratt	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 04 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 16-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8-20-06</u> .                                                 | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-15 are indefinite in the use of the term "preferably". It is not known whether the "preferred" limitation is required or not.

### ***Claim Objections***

Claim 9 is objected to because of the following informalities: Claim 9, on line 4, contains run-on words and numbers i. e. "from760". Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15 are provisionally rejected on the ground of nonstatutory double patenting over claims 45-54 of copending Application No. 10524,014. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: the claims are product by process claims, wherein the process is the same as claimed, and would have made the same product as by the instant process.

### ***Election/Restrictions***

Applicant's election with traverse of claim 1-29 in the reply filed on 3-4-09 is acknowledged. The traversal is on the ground(s) that the limitations of the claims overlap and form a single inventive concept. This is not found persuasive because the product claims do not contain process limitations, and therefore, the process is a different inventive concept, and the composition containing the product requires different ingredients, not required by the product only claims, and also does not require the instant process.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over De la Cuadra or Succar ((WO 03/024243) in view of Okada in view of applicant's specification (US 2008020606438 PG publication), Chiang et al. (5,436,022 ), and two references from Google.com.

De La Cuadra et al. (Cuadra) disclose a process of separating hot or cold break tomatoes into two streams, (a) one rich in soluble tomato solids and water, and (b) one rich in insoluble tomato solids and water. Product (a) can be further concentrated to 10 degrees Brix and combined with product b (abstract),

Succar discloses treating tomato juice with a decanter, which separates the juice into two portions, thick and thin,(serum) and concentrating the serum portion (abstract).

Step 3 is not required, but would have been within the skill of the ordinary worker to add water to a thick tomato product in order to achieve the required consistency.

Claim 1 differs from the reference in that the mass to be filtered is stirred during the separation time and in mixing water with the tomato concentrate. However, V shaped colanders or pulpers are well known, which have holes in them and the use of similarly shaped tool, which pushes the tomatoes against the walls of the colander.

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Also, Okada discloses that it is known to dewater vegetable material, which has rotary filter elements which free the material from water. The rotary filter elements are seen to serve the same function as a stirrer, since the material is moved by the rotary filter (abstract and fig. 1, col. 1, lines 15-20, col. 2, lines 40-55). Also, applicants' PG Pub/ '438 discloses that alternatively, a solid-liquid apparatus which rotates on the longitudinal central axis at a speed from 1 rpm's to 20 can be used (oo20).. It would have been within the skill of the ordinary worker to add water to a thick mixture so that it can be easily separated. Chiang et al. also, disclose that pulpers and finishers are known in order to separate tomato products (col. 4, lines 60-70). Pictures from Amazon.com, shows that food mills are known (2 pictures). Even though no date is present, the product had to have been made before Applicants' date of invention since it takes time to develop an apparatus and to get it into production. Therefore, it would have been obvious to use a vegetable mill to separate any type of tomato product, whether concentrated or fresh pulp, since the outcome is the same of separating the solids from liquid, and to stir the tomato product during separation time as shown by the combined references.

Claim 2 further requires an apparatus with a stirrer having speeds from 1-20 and other apparatus characteristics, as does claim 3 and 4. However apparatus limitations are not given weight in process claims. The particular rate of speed of stirring is seen as a function of the mechanical apparatus, and it would have been within the skill of the ordinary worker to operate at a required speed to produce the required product.

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Therefore, it would have been obvious to operate or stir the tomato product at any speed, which produces the claimed product.

Claim 5 further requires using with water, a passata or tomato juice. However, as it is known that using such ingredients would enrich the tomato concentrate, it would have been obvious to use them for such a function. Therefore, it would have been obvious to enrich the concentrate with known food ingredients.

Claims 6 and 7 require particular amounts of water to concentrate, which would have been within the skill of the ordinary worker depending on how fast the concentrate is to be further concentrated. Therefore, it would have been obvious to add particular amounts of water to the composition of the combined references.

Claim 8 further requires operating under sterile conditions, which is considered to be the well known aseptic process or sterilizing the product, which is commonly done. Therefore, it would have been obvious to use known processes of making sterile products.

Claim 9 requires using particular temperatures and presses and claim 10 repeating the process using fresh water. Chiang discloses the use of a vacuum evaporator, which uses temperatures of 66 C. to make a tomato puree having a Brix of 12 degrees (col. 5, lines 65-70, col. 6, lines 1-2). Even though applicant uses lower temperatures and particular pressures, it is seen that it would have been within the skill of the ordinary worker to lower the temperature even further in order to process at room temperatures and to maintain the color and flavors of the tomatoes which are subject to change at higher temperatures. Certainly, adding fresh water to thin the mixture, is an

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obvious step that merely thins out the mixture for ease of processing through holes in the colanders or screens. Therefore, it would have been obvious to process at low temperatures and pressures.

The limitations as to the apparatus as in claims 11 and 12 having particular size wholes are not given weight, in process claims. Sieves and colanders are known to have various size holes, and it would have been obvious to pick the size holes necessary to the process, and the length of time the product should be separated considering the bacteria levels and oxidation of the product and degradation of color and flavors. Therefore, it would have been obvious to use particular size holes in the apparatus for their known function of separating mixtures.

The further claims 13-15 are to the apparatus which is not given weight in process claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Keith Hendricks, can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Helen F. Pratt/  
Primary Examiner, Art Unit 1794

4-6-09